



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/601,250
Filing Date: June 20, 2003
Applicants: Kia et al.
Group Art Unit: 1774
Examiner: Merrick L. Dixon
Title: LOW SHRINK LOW DENSITY LAMINATE FORMULATION
Attorney Docket: H-205868 (8540R-000002)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

STATEMENT ACCOMPANYING THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Rejection mailed December 30, 2005, Applicants have filed a Notice of Appeal and a Request for Pre-Appeal Brief Review. This Statement accompanies Applicants' Request.

With a two-month extension of time, reply is timely on or before May 30, 2006. Applicants hereby petition for a two-month extension of the period of response and attach a grantable petition under 37 C.F.R. § 1.136(a).

05/15/2006 FFANAEIA-00000105 070960 10601250
01 FC:1402 ← 500.00 DA

Adjustment date: 05/16/2006 FFANAEIA
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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
H-205868 (8540R-000002)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

Application Number
10/601,250Filed
June 20, 2003First Named Inventor
Kia et al.

On _____

Art Unit
1774Examiner
Merrick L. Dixon

Signature _____

Typed or printed name Anna M. Budde

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,085.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Anna M Budde
Signature

Anna M. Budde
Typed or printed name

(248) 641-1600
Telephone number

May 11, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

REMARKS

Claims 1 to 39 are now pending in the application. As pointed out in the Reply After Final filed March 3, 2006, Claim 9 is pending by virtue of a Preliminary Amendment filed June 20, 2003.

DOUBLE PATENTING (SAME INVENTION TYPE) IN VIEW OF CO-PENDING APPLICATION 10/601,269

The Examiner clearly erred in rejecting Claims 1 to 7, 10 to 35 and 37 as claiming the same invention as Claims 11, 15, 20, 30 to 34, 37 and 45 of co-pending Application 10/601,269. The rejected claims do not recite the same invention as the co-pending claims because the claims are not of the same scope.

In support of this position, and for convenient comparison, Applicants have provided comparison Table A. See Reply After Final at pages 9-11. Applicants demonstrate that many embodiments that fall within the rejected claims would not infringe the claims of the co-pending application, and vice versa. For example, Claim 11 of the co-pending application is drawn to an automotive body panel and would not infringe rejected method Claim 1. Id. at page 12. Additionally, none of the rejected claims recite a barrier coat having fibers of less than 1 mm in length, which is a limitation recited in the claims of the co-pending application. Id. Therefore, the rejected claims do not claim the same invention as the claims of the co-pending application.

Accordingly, Applicants respectfully request the rejection under § 101 for same-type double patenting be withdrawn.

REJECTION UNDER 35 U.S.C. § 102 OVER GB 1 493 547

The Examiner clearly erred in rejecting Claims 16 to 19, 22 to 24, and 26 under

35 U.S.C. § 102(b). Applicants maintain the position that the GB Patent does not disclose at least one limitation, e.g. a barrier layer disposed between a gel coat and a laminate, of the rejected claims. Reply After Final at pages 12 to 13. Therefore, the GB Patent does not anticipate and Applicants respectfully request the rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 102 OVER OKAYAMA – *EX PARTE PFEIFFER*

The Examiner clearly erred in rejecting Claims 1 to 8 under 35 U.S.C. § 102(b) because the Okayama reference does not describe the layer compositions as applied to form the composite article of Claims 1 to 8. In particular, Claim 1 recites applying a laminate formula of a particular composition over the barrier coat. The cited reference does not describe applying a laminate formula having the recited composition. Therefore, the reference does not describe every limitation of the claims.

Furthermore, the principles of *Ex parte Pfeiffer* are not applicable and do not operate to render the claims anticipated. The claims of Pfeiffer were drawn to a method of using an article, whereas the rejected claims are drawn to a method for preparing a composite article. Applicants' method recites structural limitations that are necessarily "manipulatively distinct," i.e. the claimed process steps include applying novel compositions. For instance, rejected Claim 1 recites a method including "applying a laminate formula . . . wherein the laminate formula comprises [a particular composition]." Since the Okayama reference does not describe applying a laminate formula having the recited composition, the Okayama reference does not anticipate Applicants' claims.

In further support of Applicants' position, the Panel is respectfully referred to the Reply filed October 5, 2005 at pages 3 and 4 and the Reply After Final at page 13 and 14. For all of these reasons, Applicants respectfully request the rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

The Examiner clearly erred in rejecting Claims 10 to 15, 20, 21, 25, 27 to 32, 34 and 35 under 35 U.S.C. § 103(a). As discussed above, the Okayama reference fails to describe all of the elements of the rejected claims. The limitations lacking from the Okayama reference are also not found in the GB Patent. For instance, the GB Patent does not describe polymeric hollow microspheres or the use of a dicyclopentadiene unsaturated polyester resin. See Reply After Final at pages 14-18. Therefore, the combined references do not describe all the elements of the rejected claims.

Additionally, the Maker reference does not describe polymeric hollow microspheres. The dust described in Maker is not polymeric or comprised of hollow microspheres. The Maker reference does not describe calcium carbonate coatings. Further, the Maker reference does not describe the step of handling a glass cloth on top of the barrier coat layer. The Maker reference instead appears to refer to spraying or brushing a gel coat onto a surface of a mold. This is not the same operation as the claimed handling of a glass cloth on top of a barrier layer and applying a laminate resin composition to the cloth. The Maker reference does not overcome the deficiencies of the Okayama and GB Patent references. Thus, the combined references do not describe each and every limitation of the rejected claims.

For these reasons, Applicants respectfully submit that the rejected claims are patentable in light of the cited references.

CONCLUSION

For the reasons discussed above, Applicants respectfully submit that rejected claims 1 to 39 are patentable over the cited references. Further and favorable consideration is urgently solicited. The board is invited to telephone the undersigned Applicants' representative if that would be helpful in resolving any issues.

Respectfully submitted,

Dated: May 11, 2006

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